

### **REMARKS**

Applicant has reviewed the Office Action dated June 24, 2003, and the references cited therewith.

Claims 64, 69, and 81 are amended, claims 65 and 82 are canceled without prejudice or disclaimer, and claims 91-98 are added; as a result, claims 57-64, 66-81, and 83-98 are now pending in this application.

#### **Double Patenting Rejection**

In the Office Action, claims 57 – 90 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 39 of U.S. Patent No. 6,033,366 and claims 1 – 124 of U.S. Patent No. 6,379,308. Applicant has filed herewith a terminal disclaimer in compliance with 37 CFR 1.321 to overcome the double patenting rejection.

#### **§112 Rejection of the Claims**

In the Office Action, claims 70, 71, 86 and 88 were rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant traverses. Applicant believes the specification does provide enablement commensurate with the scope of claims 70, 71, 86, and 88.

For example, starting on page 20, line 5, the specification describes an application of one embodiment of the device for measuring venous pressure. This example describes a PTC length of approximately 4 centimeters. Starting on page 21, line 1, the specification describes an example of a device for monitoring pulmonary pressure. In this example, the PTC is approximately 1-2 cm long. On page 22, the specification describes an example of a device for monitoring intercranial pressure. In this example, the PTC is approximately 1.5 cm long. The description also discusses dynamic response and head pressure on page 13, lines 11-18, among others, and describes on page 14, lines 3-5, that the reduced length “can greatly reduce head pressure error and improve the dynamic response to a degree which is acceptable to the researcher and clinician using the pressure measurement device.” The acceptable head pressure

loss and dynamic response are different for various clinical applications. However, as noted in the specification, one skilled in the art is aware of the acceptable level for a given application. Applicant believes that one skilled in the art could make and use the claimed devices based on these descriptions, the discussion of head pressure and dynamic response, and the particular clinical application. Accordingly, these portions of the specification and accompanying figures, among others, enable a person of ordinary skill in the art to make and use the invention commensurate with the scope of the claims. Reconsideration and allowance is respectfully requested.

*§102 Rejection of the Claims*

In the Office Action, claims 69 – 72 were rejected under 35 USC § 102(b) as being anticipated by Pohndorf et al.

Applicant has amended claim 69 to better describe the subject matter recited in the claim. Applicant believes the claim is not anticipated by the cited reference since the reference does not include each limitation recited in the claim. For instance, an apparatus for measuring physiological pressure that includes a pressure transmission catheter having a lumen filled with a pressure transmitting medium and implantable in an area having a physiological pressure, “the pressure transmission catheter having a multi-durometer construction,” as recited in claim 69.

Claims 70-72 include each limitation of their parent claim are therefore also not anticipated by the cited reference. Reconsideration and allowance is respectfully requested.

*§103 Rejection of the Claims*

In the Office Action, claims 64 and 66 – 69 were rejected under 35 USC § 103(a) as being unpatentable over Brockway et al. in view of Iwata et al.

*Claims 64 and 66-68*

Applicant has rewritten claim 64 to include the subject matter of allowable claim 65. Claims 66-68 depend from claim 64. Reconsideration and allowance is respectfully requested.

Claim 69

Applicant believes amended claim 69 is not obvious in view of the cited references, since, even if combined, the combination does not include each limitation recited in the claim. For instance, a pressure transmission catheter having a lumen filled with a pressure transmitting medium and implantable in an area having a physiological pressure, "the pressure transmission catheter having a multi-durometer construction," as recited in claim 69. Reconsideration and allowance is respectfully requested.

In the Office Action, claims 73, 74, 76, 78 – 81, 83 and 85 - 90 were rejected under 35 USC § 103(a) as being unpatentable over Pohndorf et al. in view of Brockway et al.

Claims 73, 74, 76, and 78-80

Claims 73, 74, 76, and 78-80 depend from claim 69 and are not obvious in view of the cited references for the reasons given above for claim 69.

Claims 81, 83, and 85-90

Claim 81 has been amended to include the allowable subject matter of claim 82. Claims 83, 85-90 depend from claim 81. Reconsideration and allowance is respectfully requested.

In the Office Action, claims 78 – 80, 89 and 90 were rejected under 35 USC § 103(a) as being unpatentable over Pohndorf et al. in view of Brockway et al., as applied to claims 73, 74, 76, 81, 83 and 85 – 88, and further in view of Mills et al.

Claims 78-80

Claims 78-80 depend from claim 69 and are not obvious for the reasons given above for claim 69.

Claims 89 and 90

Claims 89 and 90 depend from allowable claim 81. Reconsideration and allowance is respectfully requested.

*Allowable Subject Matter*

In the Office Action, claims 57 – 63 were indicated to be allowable if the double patenting rejection was overcome.

In the Office Action, claims 65, 75, 77, 82 and 84 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 65 has been rewritten into claim 64; claim 75 has been rewritten as new claim 91. Claim 82 has been rewritten into claim 81; and claim 84 has been rewritten as new claim 96.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 359-3267) to facilitate prosecution of this application.

Applicant has enclosed a check in the amount of \$140.00 to cover the fee for adding additional claims. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

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Date 10/24/03

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24 day of October, 2003.

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